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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/599,294  | 09/25/2006  | Frederic Felten      | 324-189             | 6602             |
| 23429 7590 12/08/2009<br>LOWE HAUPTMAN HAM & BERNER, LLP<br>1700 DIAGONAL ROAD<br>SUITE 300<br>ALEXANDRIA, VA 22314 |             |                      |                     |                  |
| EXAMINER<br>WOOD, JR, STEVEN A  |             |                      |                     |                  |
| ART UNIT  |             | PAPER NUMBER         |                     |                  |
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/599,294

**Applicant(s)**

FELTEN, FREDERIC

**Examiner**

STEVEN WOOD

**Art Unit**

2462

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08/11/2009.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-7 and 9-13 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1,3-7 and 9-13 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☒ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO/SI.08)  
Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Interval Patent Application  
6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. This action is in response to Applicant's request for reconsideration of Application No. **10/599294**, which was filed on **08/11/2009**. Examiner hereby issues a final rejection of the claims.

*Examiner's Comments*

2. **Claims 2, 8** are cancelled. **Claims 9 – 13** are newly presented. **Claims 1, 3 – 7, 9 – 13** are currently pending.

3. Applicant notes that Examiner's previous rejections claims 2, 8 are now rendered moot by Applicant's cancellation of these claims. Examiner provides new grounds of rejection for **claims 9 – 13**, as necessitated by these newly presented claims, which justifies making the rejection of these claims final. Any other new grounds of rejection offered in this action are necessitated by Applicant's amendments to **claims 1, 3 – 5, 7**.

4. Applicant concedes, regarding **claim 1**, see Applicant's Remarks second full Par., Pg. 9, that Low (US 20030018726 A1) effectively transforms a current communication state (connected or disconnected) of a mobile terminal 32 in an equipment 31 of the respective mobile network 30 into an instant messaging communication state (IM state information indicating whether the device 32 is available for receiving IM messages) within gateway 2. Examiner relies on this interpretation of Low in making a final rejection of Applicant's claims. See below.

5. Applicant argues, regarding **claim 1**, see Applicant's Remarks third full Par., Pg. 9, that Low does not disclose transferring the instant message communication state from a publishing gateway to an instant messaging server connected to a packet network. However, at line 2, Pg. 10, Applicant describes gateway 2 of Low as "(the IM server)." Since Low transfers the IM communication state from gateway 2 to either a master IM gateway 2 or between gateways 2 on a peer to peer basis (Low; Par. 34) Examiner takes Applicant's argument to be unfounded and incorrect. Examiner therefore justifiably relies on this interpretation of Low in the final rejection of claim 1 detailed below.

6. Applicant further argues, regarding **claim 1**, see Applicant's Remarks first and last full Par., Pg. 10 and first full Par., Pg. 11, that according to Low the communication states conveyed to and stored in the gateway database do not comprise voluntary communication states, such as "do not disturb" or "away," decided by the user of the terminal, but are more similar to the detected communication states of Applicant's method. Applicant additionally claims that the user of a mobile device cannot select a communication state of the device that is defined independently of the detected state to make it correspond to an apparent communication state, e.g. imposed by the user.

However, this argument is unfounded and incorrect as well. Low plainly states that "IM clients send a number of commands that change the user's state or presence on the IM network. These include commands which... are sent to indicate that the user is away, idle, or does not wish to be disturbed" (Low; Par. 39). Examiner therefore justifiably relies on the disclosure by

Low in supporting the final rejection of Applicant's claims including the limitation requiring selection of a voluntary communication state and a corresponding apparent communication state.

7. **Claims 1, 3 – 7, 9 – 13** are finally rejected.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. **Claims 1, 3 – 7, 9 – 13** are rejected under 35 U.S.C. 102(b) as anticipated by Low, et al., (US 20030018726 A1) (hereinafter Low).

10. Regarding **claims 1, 7, 13**, Low discloses a method of publishing (claim 1), publishing gateway for publishing (claim 7), and an advising gateway for advising (claim 13) a communication state of a terminal connected to an access network that (is adapted to - claims 7, 13) detects a communication state of said terminal (claims 1, 7), said method including and said publishing gateway comprising: notifying said communication state of said terminal as a current communication state from said access network (claims 1, 7, 13) to a communication state publishing gateway connected to said access network (claim 1), (Par. 33; gateway 2 receives and stores IM state information from equipment 31 of a mobile communications network 30,

indicating whether the device 32 is connected to the mobile network 30 and available for receiving IM messages. Presence messages may be sent to other IM users),

And an access interface connected to said access network for receiving said notification (claims 7, 13), (Figs. 1, 2; Par. 27; instant messaging (IM) gateway 2 includes a network packet switch 6; Par. 36; packets are first received at an input port of the switch 6, which executes a packet switching process on this port).

Enquiring unit for (claims 7, 13) enquiring a database (from said publishing gateway – claim 1) via a packet network (claims 1, 7), (Fig. 1; Par. 27; instant messaging (IM) gateway 2 includes a network packet switch 6, a server 16, and a database 18, which is preferably a structured query language (SQL) database. IM gateway 2 is connected to a communications network 14 such as the Internet).

To select a voluntary communication state previously decided by said terminal in said database and to select an apparent communication state corresponding to said voluntary communication state in said database (claims 1, 7, 13), (Par. 39; IM clients send commands which indicate that the user is away, idle, or does not wish to be disturbed).

As a function of an identifier of said terminal transmitted by said publishing gateway (claims 1, 7), (Par. 40; each IM network identifies its users by assigning a unique identifier to each user, typically a character string representing a screen name or nickname).

And responsive to said apparent communication state differing from said current communication state: modifying said current communication state to said apparent communication state in said publishing gateway (claims 1, 7, 13), (Fig. 4; Par. 39; IM clients

send a number of commands that change the user's state or presence on the IM network. These commands are handled by an IM state change process at gateway 2).

And a communication state modifying unit arranged to perform said modification (claims 7, 13), (Par. 33; gateway 2).

Transforming said apparent communication state of said terminal into an instant messaging communication state (claims 1, 7, 13) in said (publishing – claim 1) (advising – claim 13) gateway, (Par. 28; server 16 executes an IM gateway process that records the state or presence of IM users using any of the known IM protocols; Par. 33; gateway 2 to store IM state information indicating whether the device 32 is available for receiving IM messages).

And a communication state management unit arranged to perform said transformation (claims 7, 13), (Par. 33; gateway 2), responsive to said apparent communication state differing from said current communication state (claim 13), (Par. 39; IM clients send a number of commands that change the user's state or presence on the IM network).

And transferring said instant messaging communication state to an instant messaging server connected to said packet network (claims 1, 7, 13) (from said publishing gateway – claim 1), (Par. 34; IM data held by the gateway 2 may be sent to a master IM gateway 2 of a number of IM gateways 2 of the network 14 on a peer to peer basis).

And an instant messaging interface arranged to perform said transfer (claims 7, 13), (Figs. 1, 2; Par. 27; instant messaging (IM) gateway 2 includes a network packet switch 6; Par. 36; packets are first received at an input port of the switch 6, which executes a packet switching process on this port), responsive to said apparent communication state differing from said current

communication state (claim 13), (Par. 39; IM clients send a number of commands that change the user's state or presence on the IM network).

11. Regarding **claim 3**, the rejection of claim 1 is incorporated and only further limitations will be addressed. Low discloses the method, wherein said voluntary communication state is selected by said terminal on a server connected to said packet network, (Fig. 4; Par. 39; IM clients send a number of commands that change the user's state or presence on the IM network. These commands are handled by an IM state change process at gateway 2, which maintains state tables on the database 18 for each user connected to an IM network through the gateway 2, including the user's presence state and a permit/deny mode).

And then stores in said database, (Low: Par. 33; gateway 2 receives and stores IM state information from equipment 31 of a mobile communications network 30).

12. Regarding **claim 4**, the rejection of claim 1 is incorporated and only further limitations will be addressed. Low discloses the method, including selecting a current action to be established in said access network of said terminal and associated with said current communication state in a database, (Par. 33; when the device 32 is disconnected from the network 30; Par. 39; when a user logs in to their IM system, or changes their state from available to unavailable, etc., gateway 2 maintains state tables that provide an indication of the presence of all of the IM users, e.g., whether an IM user is available or not).



As a function of said identifier of said terminal transmitted by said publishing gateway, (Par. 40; each IM network identifies its users by assigning a unique identifier to each user, typically a character string representing a screen name or nickname).

In order for said current action to be commanded subsequently by said publishing gateway, (Par. 33; gateway 2 stores IM state information indicating whether the device 32 is available for receiving IM messages. Presence messages may be sent to other IM users when the mobile device is connected and disconnected).

13. Regarding **claim 5**, the rejection of claim 1 is incorporated and only further limitations will be addressed. Low discloses the method, including selecting a current action to be established in said access network of said terminal and associated with said current communication state in a database, (Par. 33; when the device 32 is disconnected from the network 30; Par. 39; when a user logs in to their IM system, or changes their state from available to unavailable, etc., gateway 2 maintains state tables that provide an indication of the presence of all of the IM users, e.g., whether an IM user is available or not).

As a function of an identifier of said terminal transmitted by said publishing gateway, (Par. 40; each IM network identifies its users by assigning a unique identifier to each user, typically a character string representing a screen name or nickname).

In order for said current action to be commanded subsequently by said publishing gateway, (Par. 33; gateway 2 stores IM state information indicating whether the device 32 is available for receiving IM messages. Presence messages may be sent to other IM users when the mobile device is connected and disconnected).

selecting an action associated with said voluntary communication state, (paragraph 39; gateway 2 maintains state tables on the database 18 for each user connected to an IM network through the gateway 2, including the user's presence state and a permit/deny mode. These entries are created by the gateway when the user sends state change commands to their native IM system, logging on or changing state from available to unavailable, etc.).

and modifying said current action to said action associated with said voluntary communication state, (Par. 39; permit/deny mode is used for blocking or permitting messages from other IM users).

14. Regarding **claim 6**, the rejection of claim 5 is incorporated and only further limitations will be addressed. Low discloses the method, wherein said action associated with said voluntary communication state is selected by said terminal on a server connected to said packet network and then stores in said database, (Par. 39; gateway 2 database 18 includes a state table for each IM user of the gateway 2, including a permit/deny mode; Par. 40; contact table is populated when an IM client sends a buddy list, a permit list, or a deny list to their native IM server).

15. Regarding **claim 9**, the rejection of claim 1 is incorporated and only further limitations will be addressed. Low discloses the method, wherein said voluntary communication state is selected by a user of said terminal, (Par. 39; IM clients send commands which indicate that the user is away, idle, or does not wish to be disturbed).

16. Regarding **claim 10**, the rejection of claim 9 is incorporated and only further limitations will be addressed. Low discloses the method, wherein said voluntary communication state is defined independently of said detected communication state of said terminal, (Par. 39; IM clients send a number of commands that change the user's state or presence on the IM network. These include the commands which initiate the user's login to and logout from the IM network (**detected communication states**), and commands which are sent to indicate that the user is away, idle, or does not wish to be disturbed (**voluntary communication states independent of detected communication states – as per Applicant's arguments discussed above in Examiner's Comments**)).

17. Regarding **claim 11**, the rejection of claim 7 is incorporated and only further limitations will be addressed. Low discloses the publishing gateway, wherein the communication state management unit arranged to transform said apparent communication state of said terminal into an instant messaging communication state, (Par. 28; server 16 executes an IM gateway process that records the state or presence of IM users using any of the known IM protocols; Par. 33; gateway 2 to store IM state information indicating whether the device 32 is available for receiving IM messages).

Responsive to said apparent communication state differing from said current communication state, (Par. 39; IM clients send a number of commands that change the user's state or presence on the IM network).

18. Regarding **claim 12**, the rejection of claim 7 is incorporated and only further limitations will be addressed. Low discloses the publishing gateway, wherein the instant messaging interface is arranged to transfer said instant messaging communication state to an instant messaging server connected to said packet network, (Par. 34; IM data held by the gateway 2 may be sent to a master IM gateway 2 of a number of IM gateways 2 of the network 14 on a peer to peer basis).

Responsive to said apparent communication state differing from said current communication state, (Par. 39; IM clients send a number of commands that change the user's state or presence on the IM network).

### ***Conclusion***

19. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Wood whose telephone number is (571) 270-7318. The examiner can normally be reached on Monday to Friday 8:00 AM to 4:00 PM.

If attempts to reach the above noted Examiner by telephone are unsuccessful, the Examiner's supervisor, Seema Rao, can be reached at the following telephone number: (571) 272-3174.

The fax phone number for the organization where this application or proceeding is assigned is 571-274-7318. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/S.W./  
December 2, 2009  
Steven A. Wood  
Examiner  
Art Unit 2462

/Donald L Mills/  
Primary Examiner, Art Unit 2462